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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,196	06/13/2002	Yoichiro Sako		1498

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EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT PAPER NUMBER

2652

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,196

Applicant(s)

SAKO, YOICHIRO

Examiner

Peter Vincent Agustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “second data” recorded “by deforming the pits” recited in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, e.g.,

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Page 7, line 1: "bloc" should be --block--.

Page 7, first line of last paragraph: "optical disc 1" should be --optical disc 21--.

Page 12, line 3 of third paragraph: "theses" should be --these--.

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. Claims 14-18 are objected to because of the following informalities:

Claim 14, line 2: "which the first data" should be --which first data--.

Claims 15-18 are dependent upon claim 14.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 8 describes a recording medium configured to record second data "by deforming the pits". The applicant's specification states that the claimed second data can be recorded as the

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deformation of a part or entirety of each pit, but does not provide specific steps on how the claimed “deforming” is accomplished. Claims 9-13 are dependent upon claim 8.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Sako et al. (WO00/34947 published June 15, 2000; please refer to EP 1076332 A1 for English language full text).

In regard to claims 1-13, the intended use does not limit the recording medium structure. A statement regarding an intended use, e.g., “configured to record” of independent claims 1 & 8, does not positively recite claim structure of the recording medium or functionally related signals recorded therefrom.

Furthermore, in regard to claim 1, Sako et al. disclose a recording medium (see title) configured to record first data (abstract, lines 1-7) in a form of a track consisting of a plurality of pits, second data (abstract, lines 7-10) by displacing the pits from the track in a direction normal to the track, and content data (column 6, lines 20-26) representing contents of the first data, including identification data (column 6, lines 27-32) that indicates whether the second data is recorded on the medium.

In regard to claim 2, Sako et al. disclose that the content data further includes reproduction-mode identification data (column 6, lines 32-36: "detection result") showing modes of reproducing the first data and the second data.

In regard to claim 3, Sako et al. disclose that the reproduction-mode identification data represents a first reproduction mode (column 10, lines 5-18: "ExCD" mode) in which a signal is reproduced by performing an operation on the first data and on the second data, and a second reproduction mode (mode other than "ExCD" mode) in which the first data, the second data, or both the first and second data are reproduced.

In regard to claim 4, Sako et al. disclose a first recording area (inherent) for recording the first data and the second data and a second recording area for recording the content data (column 6, line 21: "lead-in area") that is read before the first recording area.

In regard to claim 5, Sako et al. disclose that the first data is 16-bit digital audio data modulated in an 8-to-14 modulating scheme (abstract, lines 1-3).

In regard to claim 6, Sako et al. disclose that the second data is 4-bit digital audio data modulated in an 8-to-14 modulating scheme and the first data and the second data together form 20-bit audio data (abstract, lines 1-3).

In regard to claim 7, Sako et al. disclose that the pits corresponding to the second data are displaced in the direction normal to the track by distances within a range that allows a laser beam to scan the track (column 7, line 55 thru column 8, line 6).

In regard to claims 8-13, these claims have limitations that are similar to those of claims 1-7; thus, they are rejected using the same rationale as applied against claims 1-7 above.

In regard to claim 14, Sako et al. disclose a method (see title) for reproducing data from a recording medium on which (see rejections above for similar limitations) first data, second data, or both the first data and the second data are recorded, and content data representing contents of the first data is recorded, said first data recorded in a form of a track consisting of a plurality of pits, said second data recorded by displacing the pits from the track in a direction normal to the track, and said content data including identification data that indicates whether the second data is recorded on the recording medium and reproduction-mode identification data that represents a mode for reproducing the second data, said method comprising the steps of: determining a type of the recording medium from the identification data read from the recording medium (column 6, lines 20-38); and reproducing the first data and the second data read from the recording medium in accordance with the reproduction-mode identification data, when the second data is recorded on the recording medium.

In regard to claim 15, this claim has limitations that are similar to those of claim 3; thus, it is rejected using the same rationale as applied against claim 3 above.

In regard to claim 16, Sako et al. disclose that when the reproduction-mode identification data represents the first reproduction mode (column 10, lines 5-18: "ExCD" mode), an operation is performed on two data items obtained by reproducing the first data and the second data, both read from the recording medium.

In regard to claim 17, Sako et al. disclose that when the reproduction-mode identification data represents the second reproduction mode (mode other than "ExCD" mode), either a first data item obtained by reproducing the first data or a second data item obtained by reproducing the second data is output.

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In regard to claim 18, Sako et al. disclose that the first data read from the recording medium is reproduced and output when the second data is not recorded on the recording medium (column 10, lines 19-31).

In regard to claim 19, Sako et al. disclose an apparatus (figure 3) for reproducing data from a recording medium (21) on which (see rejections above for similar limitations) first data or second data, or both the first data and the second data are recorded, and content data representing contents of the first data is recorded, said first data recorded in a form of a track consisting of a plurality of pits, said second data recorded by displacing the pits from the track in a direction normal to the track, and said content data including identification data that indicates that the second data is recorded on the medium and reproduction-mode identification data that represents a mode for reproducing the second data, said apparatus comprising: a head section (23) configured to apply a laser beam to scan the recording medium; a signal-reproducing section (24, 25, 26, 28, 29, 30, 31 & 33) configured to reproduce a signal read from the recording medium by the head section; and a control section (27) configured to determine a type of the recording medium from the reproduction-mode identification data read from the recording medium and to cause the signal-reproducing section to reproduce the first data and the second data, both read from the recording medium, in accordance with the reproduction-mode identification data, when the second data is recorded on the recording medium.

In regard to claim 20, Sako et al. disclose a first signal-processing section (26 & 29) configured to perform at least demodulation in a signal output from the head section, a second signal-processing section (28, 30 & 31) configured to perform at least demodulation on a component of the signal output from the head section, which corresponds to the displacement of

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pits from the track in a direction normal to the track, and a mixing section (33) configured to mix the data output from the first signal-processing section and the data output from the second signal-processing section.

In regard to claim 21, Sako et al. disclose a switching circuit (36) which is controlled by the control section for selecting the data output from the first signal-processing section or data output from the mixing section.

In regard to claim 22, Sako et al. disclose that the control section further controls the switching circuit to select the data output from the mixing section when the reproduction-mode identification data read from the recording medium by the head section represents a reproduction mode in which a signal is reproduced by performing an operation on the first data and on the second data (column 10, line 55 thru column 11, line18).

In regard to claim 23, Sako et al. disclose that the control section further controls the switching circuit to select the data output from the first signal-processing section when the reproduction-mode identification data read from the recording medium by the head section represents a reproduction mode in which the first data or the second data, or both the first data and the second data are reproduced (column 11, lines 33-55).

In regard to claim 24, Sako et al. disclose a switching circuit (figure 3, element 25) configured to supply the second signal-processing section with a component of a signal in accordance with a control signal supplied from the control section, said component of the signal being one corresponding to the displacement of the pits from the track in the direction normal to the track.

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In regard to claim 25, Sako et al. disclose that the control section outputs data output from the signal-reproducing section and corresponding to the first data read from the recording medium, when the identification data read from the recording medium by the head section indicates that the second data is found not to be recorded on the recording medium (column 11, lines 42-55).

Citation of Relevant Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakane et al. (US 5,936,932) disclose an optical recording medium having ID part shifting from the center of groove tracks.

Takemura et al. (US 6,172,960) disclose an optical disk recording/reproducing apparatus using multiple address block groups shifted oppositely with multiple address blocks.

Takamine et al. (US 6,240,055) disclose an address area that includes pits that are positioned at a ½ track pitch shifted from the center of the track in the direction of the radius of the optical disc.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin
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A handwritten signature in black ink, appearing to read 'William Klimowicz', with a stylized 'W' and 'K'.

**WILLIAM KLIMOWICZ
PRIMARY EXAMINER**